

DOCKET NO.: MSFT-1587/302202.1  
Application No.: 10/603,037  
Office Action Dated: May 10, 2006  
Advisory Action Dated: July 28, 2006

PATENT  
REPLY FILED UNDER EXPEDITED  
PROCEDURE PURSUANT TO  
37 CFR § 1.116

## REMARKS

In summary, claims 1-6, 8-16, 18-24, 26, 27, and 29-48 are pending. Claims 1-6, 8-16, and 32-48 stand rejected under 35 U.S.C. §101. Claims 1-6, 8-16, 18-24, 26, 27, and 29-48 stand rejected under 35 U.S.C. §102. Applicant respectfully traverses the rejections. Claims 1, 11, 32 are amended and claim 2, 12 are cancelled. No new matter is added.

### Telephone Conversation With Examiner

Applicant's representative thanks Examiner Hwang for the telephone conversation conducted on August 8, 2006. During that conversation, Applicant's representative asked Examiner Hwang if any of the previously filed Office Action Response (dated July 5, 2006) would be entered. Examiner Hwang stated that the response would not be entered because amendments were made after a final rejection.

### Claim Rejections - 35 U.S.C. §101

Claims 1-6, 8-16, 18, 19, and 32-48 are rejected under 35 U.S.C. §101 as being directed to non-statutory subject matter.

#### Method Claims 1, 3-6, and 8-10

It is asserted in the instant Office Action that "'A method' in 1<sup>st</sup> line of claim 1 is non-statutory as not being **tangibly embodied** in a manner so as to be executable." (Emphasis in original). It is further asserted that claims 2-6 and 8-10 do not add tangibility to the claimed subject matter. Applicant respectfully traverses this rejection.

Claim 1, directed to a method, is amended to include the limitation of claim 2, and claim 2 is canceled. Amended claim 1 recites, in part "accessing said database via said dimension." Accessing a data base is an executable step of a method. Accessing the database "can include reading from the database, writing to the data base, adding data to the data base, or a combination thereof." (Applicants application, last line of paragraph 0039). Accordingly, the method recited in claim 1 is executable.

Applicant does not understand Examiner's argument that statutory subject matter must be tangibly embodied. The test to determine if subject matter is statutory under 35 U.S.C. §101 is not whether the subject matter is tangibly embodied, but whether the claimed invention as a whole produces a useful, concrete and tangible result. A brief development of the law, supporting this test, was provided by Applicant in the previous Office Action Response (previous Office Action Response dated February 17, 2006). Further, this test is supported by the portions of the MPEP cited by Examiner in the instant Office Action. For example, Examiner cited a portion of MPEP 2106 (II)(A). The portion of MPEP 2106 (II)(A) cited by Examiner is repeated below, with emphasis (in bold) showing that statutory subject matter under 35 U.S.C. §101 must produce a useful, concrete and tangible result.

The claimed invention as a whole must accomplish a practical application. That is, it must produce a **"useful, concrete and tangible result."** *State Street*, 149 F.3d at 1373, 47 USPQ2d at 1601-02. The purpose of this requirement is to limit patent protection to inventions that possess a certain level of "real world" value, as opposed to subject matter that represents nothing more than an idea or concept, or is simply a starting point for future investigation or research (*Brenner v. Manson*, 383 U.S. 519, 528-36, 148 USPQ 689, 693-96); *In re Ziegler*, 992, F.2d 1197, 1200-03, 26 USPQ2d 1600, 1603-06 (Fed. Cir. 1993)). Accordingly, a complete disclosure should contain some indication of the practical application for the claimed invention, i.e., why the applicant believes the claimed invention is **useful**.

Apart from the utility requirement of 35 U.S.C. 101, **usefulness** under the patent eligibility standard requires significant functionality to be present to satisfy the **useful result** aspect of the practical application requirement. See *Arrhythmia*, 958 F.2d at 1057, 22 USPQ2d at 1036. Merely claiming nonfunctional descriptive material stored in a computer-readable medium does not make the invention eligible for patenting. For example, a claim directed to a word processing file stored on a disk may satisfy the utility requirement of 35 U.S.C. 101 since the information stored may have some "real world" value. However, the mere fact that the claim may satisfy the utility requirement of 35 U.S.C. 101 does not mean that a **useful result** is achieved under the practical application requirement. **The claimed invention as a whole must produce a "useful, concrete and tangible" result** to have a practical application.

As evident from the above portion of the MPEP cited by Examiner, qualifying statutory subject matter under 35 U.S.C. §101 is not required to be tangibly embodied. Rather, the claimed invention as a whole must produce a useful, concrete and tangible result. Applicant's claimed method provides improved data processing in connection with a data base. The improvement can result in quicker response times and more efficient queries when accessing the data base. These results are useful, concrete, tangible, and a practical application in the technological arts.

Because claim 1 recites in part "accessing said database via said dimension," because claim 1 is directed to an executable method, because claim 1 is directed to improved data processing in connection with a data base, which is a practical application in the technological arts and provides useful, concrete, and tangible results, it is respectfully requested that the rejection under 35 U.S.C. § 101 of claims 1, 3-6, and 8-10 be reconsidered and withdrawn.

**Computer-Readable Medium Claims 11, 13-16, 18. and 19**

It is asserted in the instant Office Action that "'A computer-readable medium' in 1<sup>st</sup> line of claim 11 is insufficient to render the claim **tangibly embodied** in manner so as to be executable because 'a computer-readable medium' also includes a carrier wave." (Emphasis in original).

Claim 11, directed to a computer-readable medium, is amended to recite in part "[a] computer-readable storage medium." Accordingly, it is requested that the rejection of claim 11 based on the computer-readable medium including a carrier wave be reconsidered and withdrawn.

Claim 11 also is amended to include the limitation of claim 12 and claim 12 is canceled. Support for this amended can be found through Applicant's applicant, such as in paragraphs 0019, 0020, 0021, and 0044, for example. Amended claim 11 recites in part "accessing said database via said dimension." Accordingly, the arguments presented above

with respect to the rejection of claim 1 under 35 U.S.C. §101 also apply to the rejection of claim 11 under 35 U.S.C. §101.

Because claim 11 recites in part “accessing said database via said dimension,” because claim 11 recites in part “[a] computer-readable medium comprising at least one of volatile and non-volatile storage,” because claim 11 is directed to improved data processing in connection with a data base, which is a practical application in the technological arts and provides useful, concrete, and tangible results, it is respectfully requested that the rejection under 35 U.S.C. § 101 of claims 11, 13-16, 18. and 19 be reconsidered and withdrawn.

**Data Structure Claims 32-39**

It is asserted in the instant Office Action that “‘A data structure embodied by at least one computer readable medium’ in 1<sup>st</sup> line of claim 32 is insufficient to render the claim **tangibly embodied** in a manner so as to be executable because ‘a computer-readable medium’ also includes a carrier wave,” and because a data structure is non-statutory as being non-functional descriptive material. (Emphasis in original).

Claim 32 is amended to depend upon claim 11. The arguments presented above with respect to the rejection under 35 U.S.C. §101 of claim 11 also apply to the rejection under 35 U.S.C. §101 of claim 32. Accordingly it is respectfully requested that the rejection under 35 U.S.C. § 101 of claims 32-39 be reconsidered and withdrawn.

**Method Claims 40-48**

It is asserted in the instant Office Action that “‘A method’ in 1<sup>st</sup> line of claim 40 is non-statutory as not being **tangibly embodied** in a manner so as to be executable.” (Emphasis in original).

Claim 40 is directed to a “method for retrieving data from a database,” and recites the step of “retrieving said data from said database.” As such, claim 40 is directed to an executable method. The arguments presented above with respect to the rejection of claim 1 under 35 U.S.C. §101 also apply to the rejection of claims 40-48 under 35 U.S.C. §101.

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Accordingly, it is respectfully requested that the rejection under 35 U.S.C. § 101 of claims 40-48 be reconsidered and withdrawn.

**Claim Rejections - 35 U.S.C. §102**

Claims 1-6, 8-16, 18-24, 26, 27, and 29-48 are rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent Application Publication No. 2004/0122844, in the name of Malloy *et al.* (hereinafter referred to as “Malloy *et al.*”).

In view of the Declaration submitted herewith under 37 C.F.R. §1.131 by inventors Cristian Petculescu, Amir Netz, Mosha Pasumansky, Marius Dumitru, Alexander Berger, and Paul Jonathon Sanders, Applicant respectfully submits that the subject matter of the present application was invented prior to the effective date of Malloy *et al.* The attached declaration is accompanied by an invention disclosure packet, which has been redacted by Applicant's attorney in order to remove unnecessary information, such as dates and business-related information, that is not pertinent to the claimed subject matter. The Examiner is respectfully urged to carefully review the attached declaration, which is signed by all the inventors of the present application, and to withdraw the rejections based on Malloy *et al.* Accordingly, Applicant respectfully requests that the rejection of claims 1, 3-6, 8-11, 13-16, 18-24, 26, 27, and 29-48 under 35 U.S.C. § 102 be reconsidered and withdrawn.

Should the Examiner for any reason feel that the declaration is insufficient, or that additional information is required, the Examiner is respectfully encouraged to call applicants' undersigned attorney at the phone number provided below.


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### CONCLUSION

It is requested that the forgoing arguments, remarks, and amendments be entered, and in view thereof, it is respectfully submitted that this application is in condition for allowance. Reconsideration of this application and an early Notice of Allowance are respectfully requested. In the event that the Examiner cannot allow this application for any reason, the Examiner is encouraged to contact the undersigned attorney to discuss resolution of any remaining issues.

Date: August 14, 2006

  
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